

REMARKS/ARGUMENTS

Claim 1 and 13

Independent claims 1 and 13 have been amended to better highlight various features of the claimed inventions. In particular, claim 1 has been amended to require various bat properties to be selected to strategically position the bat's sweet spot zone. Similarly, claim 13 has been amended to require various bat properties to be selected to strategically position the bat's center of mass.

35 U.S.C. §103, Obviousness Rejections

Claims 1-4, 6, 7, 11, 13-16, 18, 19, 20, and 24 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Smith 1,706,680. Claims 5 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Smith 1,706,680 and Cook 4,714,251. Claims 8 and 21 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Smith 1,706,680 and Winterowd et al. 5,944,938. Claims 10 and 23 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Smith 1,706,680 and Burns et al. 6,506,823. Claims 12 and 25 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Smith 1,706,680 and You 4,572,508.

As noted above, independent claims 1 and 13 were previously amended to add the limitation requiring the claim 1 and 13 inventions to be constructed of at least two different types of material; a feature not found in the base reference Bender et al. '440. It is respectfully submitted that none of the remaining references cited in the Office Action cure such deficiency in the base reference Bender et al. '440. As is well known, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if

there is some suggestion or incentive to do so.”¹ (emphasis original) Indeed, “virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, ' 103.”² Consequently, “the task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.”³ “[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness.”⁴

It has been respectfully submitted that Bender et al. teaches away from the Applicants’ invention. First, Bender et al. teach constructing a bat using only one type of wood and TESTING each individual piece of wood so that a bat may be constructed using more dense wood in areas where the ball normally strikes the bat. In contrast, the Applicant’s invention requires no testing of the wood to construct a bat having more dense wood in area where the ball normally strikes the bat. Second, Bender et al. provide no teachings relating to selecting various bat properties so as to strategically position the bat’s sweet spot zone as claimed by the Applicants.

In addition, it has been respectfully submitted that none of the secondary references suggest nor do they provide motivation to combine the teachings of the various secondary references with the Bender et al. teachings to achieve the Applicants’ claim 1 and 13 inventions. It is respectfully submitted, therefore, that none of the cited secondary references overcome the above identified deficiency in the base reference. The remaining dependent claims simply add further patentably distinguishable features to the claim 1 and 13 inventions. For at least these reasons, Applicants

¹ Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966)

² Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

³ ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

⁴ Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

respectfully traverse the above identified 103 rejections and submit that the rejected claims are in condition for allowance.

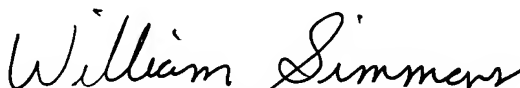
As for dependent claims claim 6 and 7 and 18-20, such claims require the thin strips making up the bat to have a thickness of either (a) about $1/32^{\text{nd}}$ of an inch to about $1/12^{\text{th}}$ of an inch or (b) about 0.00787 inches to about 0.375 inches. Using such thin strips one can better position a bat's sweet spot zone or center of mass. None of the cited references provide for such teachings nor do they make such a feature obvious. Only after reading the Applicant's disclosure do such teachings become obvious. As previously noted: "[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness."⁵

Therefore, applicants respectfully request favorable action and withdrawal of the present rejections. The Examiner is invited to call the undersigned at his convenience to resolve any remaining issues. Please charge any additional fees required by this Amendment to Deposit Account No. 503176.

Respectfully submitted,

March 4, 2005

Date



William Monty Simmons

Reg. No.: 53,910

Simmons Patents

P.O. Box 1560

Lenoir, NC 28645

(828) 757-9689

⁵ Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).